

species. Based upon these amendments to the claims, the entirety of the claims found in this application must be recombined for consideration by the Examiner prior to allowance.

With the foregoing amendments to claims, and the finding of unobviousness, this application should be allowed.

Response to 103

Applicant has amended the claims to cover all of the species disclosed in the application. Because of this, we believe the 103 rejection is moot. However, it is our desire to fully explain the inapplicability of the references cited notwithstanding the amended claims.

A primary novelty of the present invention is to combine several known and novel elements to perfect a more suitable construction panel capable of withstanding environmental forces and in conformity with, and even surpassing, existing building codes.

The applicant respectfully traverses the Examiner's rejection as to claims 1 and 2 founded on 35 U.S.C. § 103 based upon Herren (6,26,0318) in view of Hatzinikolas (5,313,752) and Tellenaar (6,705,056)). The Examiner explained in the rejection that Herren discloses a fire-stop and backing device; (also known as a "3-in-1") Tellenaar discloses a second flange extending perpendicularly upward from the second end of the metal bridge; and Hatzinikolas discloses an anchor means attached to a second terminal end. However, neither the Herren patent nor the Tollenaar patent teach or disclose any method or way to incorporate a slideable means for anchoring the studs. Neither does the Hatzinikolas patent teach nor discloses any mechanism or method for providing a metal bridge or other fire stopping device especially the novel type of device incorporated by the present invention.

As to the substance of the rejection, we believe the Examiner misunderstands the several points of novelty of the present invention which is to create a regular or truss panel for pre-

assembly that is capable of having vertical and horizontal expansion and contraction features and has a novel backing device such as the 3-in-1 or the novel 3-in-1 which is formed by attaching two 3-in-1 assemblies to form a box-like shape.

An examiner may not read into the prior art elements not disclosed but there must be some teaching or suggestion, or motivation to combine or modify the references. In re Dance, 160 F.3d 1339, 1343 (Fed. Cir. 1993). Therefore, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination and/or modification. Id.; Heidelberger Druckmaschinen v. Hantscho Commercial, 21 F.3d 1068, 1072 (Fed. Cir. 1994); In re Geiger, 815 F.2d 686, 688 (Fed. Cir. 1987). Consequently, it is incumbent upon the Examiner to show the motivation of the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, to select, combine, and/or modify the elements from the prior art references for combination in the matter claimed. In re Rouffet, 149 F.3d at 1357. Moreover, the fact that the modification or combination would be well within the ordinary skill in the art, by itself, is insufficient to meet this criterion. Al-Site Corp. v. VSI Intern., Inc., 174 F.3d 1308, 1324 (Fed. Cir. 1999).

Not unlike the obviousness rejection in In re Debiczak, 175 F.3d 994, 1000, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), the Examiner has failed to “identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them.” To satisfy the burden of obviousness in light of combining prior art references, the Examiner must present “some objective teaching leading to the combination” of prior art references. Id. No such suggestions, teaching or motivation has been presented here for the use or modification of any of the three prior art references for incorporating all of the known and

novel elements described above. Thus, without evidence of such objective suggestion, teaching or motivation to combine all of these elements, the rejection based upon improper] hindsight.”

Id.

Therefore, we respectfully request that amended claims 1-19 be rejoined and allowed to issue in their currently amended form along with new claim 20.

In the Claims

To comport with the instruction of the Examiner provided on July 12, 2006, during a telephonic interview, the claims of the application have been amended. Applicant's amended independent claims reflect a generic embodiment which covers all of the novel species. This generic panel embodiment comprises a plurality of parallel studs with reinforcement means between the studs and an expansion-contraction means to expand or contract the panel in response to environmental forces and, expanded or reduced the panel to fit within a space without disassembling or cutting said assembly.

Attached hereto as Exhibit “A” is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned “**Claims - Marked Up Version.**”

Attached as Exhibit “B” is a clean version of the changes made to the claims by the current amendment. The attached page is captioned “**Claims - Clean Version.**”

Attached as Exhibit “C” is the Claims Listing pursuant to M.P.E.P. § 714(c). The attached page is captioned “**Claims - Listing.**”

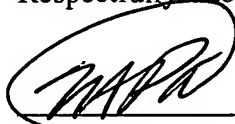
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Conclusion

Applicants respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'MHP', is written over a horizontal line.

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PLEASE RESPOND TO:

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